

## REMARKS

Claims 1-11, 13, 15-17, 19, 22, 25-26 and 28 are pending. Claims 12, 14, 18, 20-21, 23-24 and 27 were previously cancelled.

### **I. The Restriction Requirement and Applicant's Provisional Election**

The Examiner required restriction, under 35 U.S.C. §§ 121, 372, between the following groups as these inventions or groups of inventions allegedly are not so linked as to form a single general inventive concept under PCT Rule 13.1.

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| Group I    | claims 1-7, 9, 11, 16-17 and 19, drawn to a polypeptide, the polynucleotide encoding the polypeptide, a host cell, method of making the polypeptide, and method of using the polypeptide to screen for agonists. |
| Group II   | claim 8, drawn to a transgenic animal.   |
| Group III  | claim 10, drawn to an antibody.  |
| Group IV   | claims 13 and 28, drawn to a hybridization assay.  |
| Group V    | claim 15, drawn to a PCR amplification assay.  |
| Group VI   | claim 22, drawn to a method of screening for an antagonist.  |
| Group VII  | claim 25, drawn to a protein binding assay.  |
| Group VIII | claim 26, drawn to a method of screening for a compound that modulates the protein activity.   |
| Group IX   | claim 27, drawn to a method of screening for a compound that modulates the protein activity.   |
| Group X    | claim 28, drawn to a method of assessing toxicity of a compound by a DNA hybridization assay.  |

The Examiner further required an election of a single polypeptide, polynucleotide (encoding a single polypeptide) or an antibody (specific for a single polypeptide sequence) depending on the above inventive Group elected by Applicants.

In response to the restriction requirement, Applicants hereby provisionally elect, **with traverse**, Group I, claims 1-7, 9, 11, 16-17 and 19, drawn to a polypeptide, the polynucleotide encoding the polypeptide, a host cell, method of making the polypeptide, and method of using the polypeptide to screen for agonists. With respect to the Examiner's requirement that Applicant elect a sequence, Applicants provisionally elect the polynucleotide depicted in SEQ ID NO:31 encoding the polypeptide of SEQ ID NO:4.

**II. In Accordance With Office Practice, The Examination Of Claims To Ten Polynucleotide Sequences Does Not Create An Undue Burden**

Applicants draw the Examiner's attention to Section 803.04 of the Manual of Patent Examining Procedure. While contending that nucleotide sequences that encode different proteins "constitute independent and distinct inventions" the Commissioner has decided to "permit a reasonable number of such nucleotide sequences to be claimed in a single application" so as to "further aid the biotechnology industry in protecting its intellectual property." See *id.* To this end, the Patent Office "determined that normally ten sequences constitute a reasonable number for examination purposes" and that that number does not create "an undue burden on the Office." *Id.* Indeed, the Office states that "up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction." *Id.* Accordingly, the Examiner's contention that Groups IV to VI are "distinct from the other" and, therefore, subject to restriction, is not consistent with Office practice.

Indeed, under the "Examples of Nucleotide Sequence Claims" subsection of Section 803.04, the Office states that "[O]nly the *ten* nucleotide sequence selected in response to the

restriction requirement and any other claimed sequences which are patentably indistinct therefrom *will* be examined” (emphasis added).

For this reason, Applicants contend that the polynucleotides depicted in SEQ ID NO:32-40, should be examined alongside the polynucleotides of SEQ ID NO:31. Accordingly, Applicants kindly request that the Examiner rejoin SEQ ID NO:32-40 and examine together the polynucleotides of SEQ ID NO:31-40.

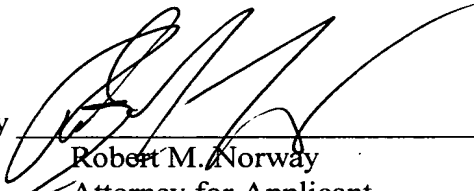
### **III. Conclusion**

Applicants respectfully request examination of claims 1-7, 9, 11, 16-17 and 19 of Group I as drawn to the polypeptides of SEQ ID NO:4-13 and the polynucleotides of SEQ ID NO:31-40 which encode those polypeptides.

If there are any fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 19-0741. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should be charged to our Deposit Account.

Respectfully submitted,

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